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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/383,981	08/26/1999	KEN HAYWOOD	45429.79728	7242

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EXAMINER

GHEE, ASHANTI

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/383,981

Applicant(s)

HAYWOOD ET AL.

Examiner

Ashanti Ghee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,14-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) 2,13 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,14-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to the following communications: amendment B filed on 3/12/03.
2. This application has been reconsidered. Claims 1, 3-12, 14-18, and 20-22 are pending. Claims 2, 13, and 19 are canceled.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Savitzky et al. (US Patent No. 6,012,083).

Regarding claim 1, Savitzky discloses a method for submitting a document in electronic form to a service bureau for printing comprising the steps of: receiving a print command input (inherent in print a document requested by a user) to a computer (Client A) for printing a document (document 66) stored in memory (storage devices) accessible to the computer (col. 11, lines 48-col. 12, lines 1-65); and responsive to the print command, routing the document over the Internet to a service bureau for printing (col. 12, lines 42-col. 13, lines 1-44); automatically activating a communication browser (which reads on a printer agency 60 rendering print preview for display when a print document request is made by the user; col. 12, lines 42-48) program (document-centric interface) in the computer ("when a user requests via a browser that an HTML document 66 to be printed on printer 62, the user simply sends a request for document 66 to printer agency 60" reads on automatically activating a communication browser program; col. 12, lines 66-col. 13, lines 1-14); and transmitting the document (document) to a server (server A) associated with the service bureau (proxy agent 36 reads on service bureau; col. 11, lines 48-col. 12, lines 1-10).

Regarding claim 6, Savitzky discloses the method wherein said step of receiving includes the step of receiving the print command from within an active application (col. 12, lines 58-col. 13, lines 1-14).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savitzky et al. (US Patent No. 6,012,083) in view of Tonkin (US Patent No. 6,134,568).

Regarding claim 3, Savitzky does not disclose the method further comprising the steps of: retrieving an Internet print web page from the server, the Internet print web page including information identifying plural print job options; displaying the Internet print web page on the computer, the Internet web page including a print job order form; and responsive to a user selection of one or more print job options identified on the print job order form, transmitting the print job order form to the service bureau.

However, Tonkin discloses the method further comprising the steps of: retrieving an Internet print web page (facility's home web page) from the server (processing facility reads on the server; col. 5, lines 53-col. 6, lines 1-8), the Internet print web page including information identifying plural print job options (col. 7, lines 12-65); displaying the Internet print web page (facility's home web page) on the computer (remote terminal reads on the computer; col. 5, lines 39-67), the Internet web page including a print job order form (col. 13, lines 25-51); and responsive to a user selection of one or more print

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job options identified on the print job order form, transmitting the print job order form to the service bureau (col. 13, lines 13-41).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Savitzky and Tonkin due to both references disclosing Internet printing systems to allow a user to preview a document prior to assembly to prevent any miscommunication problems that may arise.

Regarding claim 5, Savitzky discloses the method wherein the print job options include service bureau location (col. 11, lines 1-21). Tonkin does not specifically disclose the method wherein the print job options include service bureau location.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Savitzky and Tonkin due to both references disclosing Internet printing systems to allow a user to preview a document prior to assembly to prevent any miscommunication problems that may arise.

Regarding claim 7, Savitzky does not disclose the method wherein the active application can be any one of a word processing program, a database program, a graphics program, or a multimedia program.

However, Tonkin discloses the method wherein the active application can be any one of a word processing program, a database program, a graphics program (evident in Java applet), or a multimedia program (col. 5, lines 39-52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Savitzky and Tonkin

due to both references disclosing Internet printing systems to allow a user to preview a document prior to assembly to prevent any miscommunication problems that may arise.

Regarding claim 10, Savitzky does not disclose the method further comprising the step of receiving an acknowledgment that the document has been submitted to the service bureau for printing.

However, Tonkin discloses the method further comprising the step of receiving an acknowledgment that the document has been submitted to the service bureau for printing (col. 14, lines 24-29).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Savitzky and Tonkin due to both references disclosing Internet printing systems to allow a user to preview a document prior to assembly to prevent any miscommunication problems that may arise.

7. Claims 4, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savitzky et al. (US Patent No. 6,012,083) in view of Tonkin (US Patent No. 6,134,568) further in view of Cheng et al. (US Patent No. 6,012,070).

Regarding claim 4, Savitzky and Tonkin do not disclose the method wherein the server is an intermediary server, and said step of transmitting includes the step of transmitting the print job order form by the way of the server to a server of the service bureau.

However, Cheng discloses the method wherein the server is an intermediary server, and said step of transmitting includes the step of transmitting the print job order

form by the way of the server (server station 100) to a server (customer service station 105) of the service bureau (production station 106 reads on the service bureau; col. 9, lines 44-col. 10, lines 1-53).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Savitzky, Tonkin, and Cheng due to all references disclosing an Internet printing system to allow simple yet professional looking creation of customized business forms or brochures and provide transmission of those forms or brochures to a printing facility.

Regarding claim 8, Savitzky and Tonkin do not disclose the method further comprising the step of displaying plural printer routing options, one of the routing options being the Internet print shop.

However, Cheng discloses the method further comprising the step of displaying plural printer routing options, one of the routing options being the Internet print shop (col. 5, lines 46-col. 6, lines 1-13).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Savitzky, Tonkin, and Cheng due to all references disclosing an Internet printing system to allow simple yet professional looking creation of customized business forms or brochures and provide transmission of those forms or brochures to a printing facility.

Regarding claim 9, Savitzky and Tonkin do not disclose the method wherein another of the printer routing options is a direct-networked printer.

However, Cheng discloses the method wherein another of the printer routing options is a direct-networked printer (col. 5, lines 46-col. 6, lines 1-2).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Savitzky, Tonkin, and Cheng due to all references disclosing an Internet printing system to allow simple yet professional looking creation of customized business forms or brochures and provide transmission of those forms or brochures to a printing facility.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Savitzky et al. (US Patent No. 6,012,083) in view of Bellucco et al. (US Patent No. 5,524,085) further in view of Cheng et al. (US Patent No. 6,012,070).

Regarding claim 11, Savitzky does not disclose the method wherein the document includes multimedia content.

However, Bellucco discloses the method wherein the document includes multimedia content (col. 4, lines 23-col. 5, lines 1-14).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Savitzky and Bellucco due to both references disclosing printing systems to provide additional space with a job-ticket containing special instructions.

9. Claims 12, 16-19, and 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Tonkin (US Patent No. 6,134,568).

Regarding claim 12, Tonkin discloses a computing machine comprising: a computer (remote terminal) controlled by software modules (inherent in client terminal having software modules; col. 5, lines 28-col. 6, lines 1-20); a first module (inherent in processing facility 16) to sense an Internet print request (monitors for requests reads on sense an Internet print request; col. 5, lines 39-67); and a second module (inherent in processing facility 16) to automatically launch a communications browser program ("an initial document creation window and a Java applet which can be executed on a remote terminal to enable a user to preview a specified document" reads on automatically activating a communication browser program; col. 5, lines 39-col. 6, lines 1-20) module (document creation window) to access a server (inherent within the document production location) associated with a service bureau at a predefined address (processing facility routes a message addressed to that document production location reads on predefined message; col. 3, lines 41-col. 4, lines 1-24), the server providing the browser with a print order form (col. 5, lines 39-col. 6, lines 1-20); a third module (graphical user interface) to display the print order form (order information reads on the print order form; col. 6, lines 1-63); and a fourth module (inherent in processing facility 16) to transmit print order data and a document to be printed to the server providing the browser with the print order form (col. 6, lines 1-63).

Regarding claim 16, Tonkin discloses the machine further comprising an applications module (graphical user interface) which is active when during operation of said first and second modules (col. 6, lines 22-col. 7, lines 1-11).

Regarding claim 17, Tonkin discloses the machine wherein the applications module can be any one of a word processing program, a database program, a graphics program (Java applet), or a multimedia program (col. 5, lines 39-52).

Regarding claim 18, Tonkin discloses a computer readable medium to control a computer and having modules stored therein, the media comprising: a first module (inherent in processing facility 16) to sense an Internet print request (monitors for requests reads on sense an Internet print request; col. 5, lines 39-67); and a second module (inherent in processing facility 16) to launch a communications browser program ("an initial document creation window and a Java applet which can be executed on a remote terminal to enable a user to preview a specified document" reads on automatically activating a communication browser program; col. 5, lines 39-col. 6, lines 1-20) module (document creation window) to access a server (inherent within the document production location) associated with a service bureau at a predefined address (processing facility routes a message addressed to that document production location reads on predefined message; col. 3, lines 41-col. 4, lines 1-24), the server providing the browser with a print order form (col. 5, lines 39-col. 6, lines 1-20); a third module (graphical user interface) to display the print order form (order information reads on the print order form; col. 6, lines 1-63); and a fourth module (inherent in processing facility

16) to transmit print order data and a document to be printed to the server providing the browser with the print order form (col. 6, lines 1-63).

Regarding claim 21, Tonkin discloses the computer readable medium further comprising an applications module (graphical user interface) which is active when during operation of said first and second modules (col. 6, lines 22-col. 7, lines 1-11).

Regarding claim 22, Tonkin discloses the computer readable medium the applications module can be any one of a word processing program, a database program, a graphics program (Java applet), or a multimedia program (col. 5, lines 39-52).

Claim Rejections - 35 USC § 103

10. Claims 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin (US Patent No. 6,134,568) in view of Bellucco et al. (US Patent No. 5,524,085).

Regarding claim 14, Tonkin does not disclose the machine wherein the document to be printed includes multimedia content.

However, Bellucco discloses the machine wherein the document to be printed includes multimedia content (col. 4, lines 23-col. 5, lines 1-14).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Tonkin and Bellucco due to both references disclosing printing systems to provide additional space with a job-ticket containing special instructions.

Regarding claim 20, Tonkin does not disclose the computer readable medium wherein the document to be printed includes multimedia content.

However, Bellucco discloses the computer readable medium wherein the document to be printed includes multimedia content (col. 4, lines 23-col. 5, lines 1-14).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Tonkin and Bellucco due to both references disclosing printing systems to provide additional space with a job-ticket containing special instructions.

Response to Arguments

11. Applicant's arguments filed on 3/12/03 have been fully considered but they are not persuasive.

Applicant argues that Savitzky et al. fails to disclose the step of automatically activating a communication browser program in the computer upon selection of the print command.

Savitzky discloses when a user requests, via a browser, that an HTML document 66 be printed on printer 62, the user simply sends a request for document 66 to printer agency 60 (see col. 12, lines 42-col. 13, lines 1-44) which reads on the step of automatically activating a communication browser program in the computer upon selection of the print command.

Applicant also argues that Tonkin fails to disclose the second module to automatically launch a communications browser module upon selection of the Internet

print request to access a server associated with a service bureau at a predefined address.

Tonkin discloses upon receiving a user request in step 204, processing facility 60 sends a response message includes HTML code to create an initial document creation window and a Java applet which can be executed on a remote terminal to enable a user to preview a specified document (see col. 5, lines 39-col. 6, lines 1-20) which reads on the second module to automatically launch a communications browser module upon selection of the Internet print request to access a server associated with a service bureau at a predefined address.

Previous rejections stand.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashanti Ghee whose telephone number is (703) 306-3443. The examiner can normally be reached on Mon-Thurs and alt. Fri. (7-4PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9313 for regular communications and (703) 872-9313 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Ashanti Ghee
Examiner
Art Unit 2622

ag
April 9, 2003